## REMARKS

Claims 130-152 are pending. Claims 130-152 stand rejected. Applicants respectfully request reconsideration of the pending rejections based on the amendments and the following comments.

### Obviousness-Type Double Patenting Rejections

**A. U.S. Patent No. 6,812,219.**

Claims 130-131 and 137-149 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-32 of U.S. Patent No. 6,812,219 ("the '219 patent"). Claims 1-29 of the '219 patent recite, *inter alia*, methods of treating a flavivirus or pestivirus infection by administering one of three specific β–D-2'-C-methyl pyrimidine ribonucleosides or salts, esters or prodrugs thereof. Claims 30-32 of the '219 patent recite methods of treating a flavivirus or pestivirus infection by administering a β–D-2'-C-branched pyrimidine ribonucleoside.

An obviousness-type double patenting rejection is appropriate only when the claims at issue are not "patentably distinct" from the claims of a commonly owned earlier patent. *See Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 967 (Fed. Cir. 2001). A claim is not patentably distinct from an earlier patent claim if the later claim is "obvious over, or anticipated by, the earlier claim." *Id.* at 968. Applicants request withdrawal of the double patenting rejection because the instant claims are not obvious over or anticipated by the claims of the '219 patent.

Instant claims 130-131 and 137-149 recite, *inter alia*, methods of treating Hepatitis C virus using a purine or pyrimidine β–D-2'-methyl-ribofuranosyl nucleoside.

The claims of the '219 patent disclose methods of treating flavivirus or pestivirus infections, while the instant claims recite methods of treating Hepatitis C virus infections. Hepatitis C virus is not a flavivirus or a pestivirus. For this reason, the instant claims are patentably distinct from the claims of the '219 patent.

**B. U.S. Patent No. 7,148,206.**

Claims 130, 132-146 and 150-152 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-42 of U.S. Patent No. 7,148,206 ("the '206 patent"). Claims 1-42 of the '206 patent recite, *inter alia*,

methods of treating a flavivirus or pestivirus infection by administering a β–D-2'-C-branched purine ribonucleoside.

Instant claims 130, 132-146 and 150-152 recite, *inter alia*, methods of treating Hepatitis C virus using a purine or pyrimidine β–D-2'-methyl-ribofuranosyl nucleoside.

The '206 patent claims certain methods of treating flavivirus or pestivirus infections, while the instant claims recite certain methods of treating Hepatitis C virus infections. Hepatitis C virus is not a flavivirus or a pestivirus. For this reason, the instant claims are patentably distinct from the claims of the '206 patent.

**C. U.S. Patent No. 7,105,493.**

Claims 130-152 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-18 of U.S. Patent No. 7,105,493 ("the '493 patent"). Claims 1-18 of the '493 patent recite, *inter alia*, methods of treating a flavivirus or pestivirus infection by administering a β–D-2'-methyl-ribofuranosyl nucleoside.

Instant claims 130-152 recite, *inter alia*, methods of treating Hepatitis C virus using a purine or pyrimidine β–D-2'-methyl-ribofuranosyl nucleoside.

Claims 1-18 of the '493 patent disclose methods of treating flavivirus or pestivirus infections, while the instant claims recite methods of treating Hepatitis C virus infections. Hepatitis C virus is not a flavivirus or a pestivirus. Therefore, the instant claims are patentably distinct from the claims of the '493 patent.

**D. Provisional Obviousness-Type Double Patenting Rejections over U.S. Patent Application Nos. 10/609,298; 11/005,440; 11/005,443; 11/005,444; 11/005,446 and 11/005,466.**

Claims 130-152 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent Application Nos. 10/609,298; 11/005,440; 11/005,443; 11/005,444; 11/005,446 and 11/005,466.

If provisional obviousness-type double patenting rejections are the only rejections remaining in an earlier filed pending application, the Examiner should withdraw those rejections and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer. Manual of Patent Examination Procedure § 804, subsection I.B.

The filing date of the instant application is June 20, 2002. The filing date of U.S. Patent Application No. 10/609,298 is June 27, 2003. The filing date of each of U.S. Patent

Application Nos. 11/005,440; 11/005,443; 11/005,444; 11/005,446 and 11/005,466 is December 6, 2004. Therefore, because the instant application is the earlier-filed application, and only provisional obviousness-type double patenting rejections remain, Applicants respectfully request that the Examiner withdraw the rejections and allow the instant application to issue as a patent without a Terminal Disclaimer.

## CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Please apply fees for the extension of time for two months ($450.00) and any other charges, or any credits, to Jones Day Deposit Account No. 503013.

If the Examiner believes it would be useful to advance prosecution, the Examiner is invited to telephone the undersigned at (858) 314-1200.

Respectfully submitted,

Date: May 4, 2007

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